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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/643,872

08/20/2003

Yukio Katsuzawa

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7590

11/12/2004

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EXAMINER

NGUYEN, HANH N

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/643,872

Applicant(s)

KATSUZAWA ET AL.

Examiner

Nguyen N Hanh

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "a fan on the side opposite the motor body with respect to the cylindrical member" in claims 3, 4 and 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroyuki et al. (JP 10-146021) in view of Endo.

Regarding claim 1, Hiroyuki et al. show an air-cooled motor comprising: a motor body in which a through hole (7 in Fig. 1) is formed in a rotary shaft; a supply section (33) for supplying a fluid to the through hole; a cylindrical member (4) surrounding the supply section; and a cooling fan (37) provided on the side opposite the motor body with respect to the cylindrical member, wherein a passage (shown by arrows inside

cylindrical member) to distribute cooling air toward the cooling fan is provided in the cylindrical member. Hiroyuki et al. fail to show a window is provided in the cylindrical member so that the supply section can be visually observed.

However, Endo discloses an electric machine comprising a capsule (or a housing) to cover the components of the electric machine and a window (25 in Fig. 4) provided on the capsule for the purpose of observing the state of operation of the machine (abstract and Col. 1, lines 27-32)

Since Hiroyuki et al. and Endo are in the same field of endeavor, the purpose disclosed by Endo would have been recognized in the pertinent art of Hiroyuki et al.

It would have been obvious at the time the invention was made to a person having an ordinary skill in the art to modify Hiroyuki et al. by providing a window in the cylindrical member so that the supply section can be visually observed as taught by Endo for the purpose of observing the state of operation of the machine.

Regarding claim 3, Hiroyuki et al. show all limitations of the claimed invention except showing a cylindrical member wherein at least a part of the cylindrical member is made of a transparent material so that the supply section can be visually observed.

However, Endo discloses an electric machine comprising a capsule (or a housing) to cover the components of the electric machine and wherein the capsule is made of a transparent material for the purpose of observing the state of operation of the machine (abstract and Col. 1, lines 27-32)

Since Hiroyuki et al. and Endo are in the same field of endeavor, the purpose disclosed by Endo would have been recognized in the pertinent art of Hiroyuki et al.

It would have been obvious at the time the invention was made to a person having an ordinary skill in the art to modify Hiroyuki et al. by forming the cylindrical member with a transparent material so that the supply section can be visually observed as taught by Endo for the purpose of observing the state of operation of the machine.

Regarding claim 2, Hiroyuki et al. and Endo disclose the claimed invention except for showing the window is detachably. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the window detachably, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 4, Hiroyuki et al. also show the air-cooled motor wherein a passage for distributing cooling air toward the cooling fan is provided in the cylindrical member (Fig. 1).

Regarding claim 5, Hiroyuki et al. and Endo disclose the claimed invention (refer to the rejection of claim 1) except for showing the window is detachable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the window detachably, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 6, Hiroyuki et al. and Endo disclose the claimed invention (refer to the rejection of claim 3) except for showing the transparent part is detachable. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to make the transparent part detachable, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

### ***Response to Arguments***

3. Applicant's arguments filed 8/26/04 have been fully considered but they are not persuasive. The applicant's argument is on the ground that "the reference the Examiner relies on, Endo, does not suggest discovery of an abnormal state of the supply section of the motor, therefore Endo does not provide any motivation to combine Endo with JP 10-146201". The Examiner respectfully disagrees with the Applicant. It is noted that there is essentially no difference between the structure of JP 10-146201 and the structure of the present invention. The only difference is the provision of the window to observe the area of interest inside the motor (in the instant case, the supply section). However, Endo taught a window can be use observe the area of interest inside the motor (an operation-indicating wheel). Therefore, it is obvious to modify JP 10-146201 as suggested by Endo.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Information on How to Contact USPTO***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh N Nguyen whose telephone number is (571) 272-2031. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberger, can be reached on (571) 272-2044. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

HNN

November 5, 2004

  
DARREN SCHUBERGER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800